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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Ned Hoffman

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EXAMINER

ZELASKIEWICZ, CHRYSTINA E

ART UNIT

PAPER NUMBER

3621

NOTIFICATION DATE

DELIVERY MODE

05/14/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@techlaw.com

Office Action Summary	Application No. 09/639,948	Applicant(s) HOFFMAN, NED	
	Examiner CHRYSTINA ZELASKIEWICZ	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 32-48, 50-56, 58-63, 65, 67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32-48, 50-56, 58-63, 65, 67-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>March 12, 2010</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 C.F.R. § 1.114

1. A request for continued examination ("RCE") under 37 C.F.R. § 1.114, including the fee set forth in 37 C.F.R. § 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 C.F.R. § 1.114, and the fee set forth in 37 C.F.R. § 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 C.F.R. § 1.114. Applicant's submission filed on March 12, 2010 has been entered.

Acknowledgements

2. This action is in reply to the RCE filed March 12, 2010.
3. Claims 32-48, 50-56, 58-63, 65, 67-68 are currently pending and examined
4. This Office Action is given Paper No. 20100430 for references purposes only.

IDS

5. The Information Disclosure Statement filed on March 12, 2010 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

Claim Rejections - 35 USC § 112, 2nd paragraph

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 32-48, 50-56, 58-63, 65, and 67 are rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01.

a. The omitted structural cooperative relationships are: “a communication input apparatus”; “an electronic communication authorization platform”; “an electronic identifier”; and “a rule-module clearinghouse”. These elements are not tied to the other elements of the system claim (e.g. biometric input apparatus and master electronic identifier).

8. Claim 68 is rejected under 35 U.S.C. §112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

b. The limitation of “an electronic communication formation step, wherein at least one communication comprising electronic data is formed” is not tied to any other steps in the claim.

9. Claim 68 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

c. Claim 68 states “an electronic communication formation step”, “a bid biometric transmittal step”, “a user identification step”, “an electronic communication authorization step”, “a rule-module invocation step”, and “an electronic communication execution step”.

d. Claim 68 is vague and indefinite because it is unclear whether Applicant is invoking 35 U.S.C. § 112, 6th paragraph. Please see Ex parte Rodriguez, 92 USPQ2d 1395 (Bd. Pat. App. & Int. 2009), also available at <http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd080693.pdf>.

e. For prior art purposes only, Examiner will assume that Applicant is NOT invoking 112, 6th paragraph.

10. Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 68 is rejected under 35 U.S.C. §103(a) as being unpatentable over Drexler (US 5,457,747), in view Gullman et al. (US 5,280,527), and further in view of Osten et al. (US 5,719,950).

Claim 68

13. Drexler discloses the following limitations:

- f. a bid biometric transmittal step, wherein a bid biometric sample (biometric information), taken directly from the person of the user using a biometric input apparatus, is electronically transmitted to at least one electronic identifier (C7 L30-63);
- g. a user identification step, wherein a processor within an electronic identifier compares the bid biometric sample (biometric information) to at least one registration biometric sample previously stored in the at least one electronic identifier (library), for producing either a successful or failed identification of the user (C6 L17-37, C7 L18-63).

14. Drexler does not disclose the following limitations:

- h. an electronic communication formation step... formed;
- i. wherein an electronic communication is biometrically-authorized... cards.

15. Gullman discloses the following limitations:

- j. an electronic communication formation step, wherein at least one communication comprising electronic data (electronic funds transfer) is formed (abstract).

16. Osten discloses the following limitations:

k. wherein an electronic communication is biometrically-authorized without the user having to present smartcards or magnetic stripe cards (fingerprint analysis with pulse oximetry and electrocardiography) (C4 L1-14).

17. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine Drexler, in view of Gullman, and further in view of Osten because 1) a need exists to deter fraud in electronic benefit transfer systems (Drexler C 2 L 22-27); 2) a need exists to provide security measures for safeguarding access to information (Gullman C1 L1-67, C2 L1-17); and 3) a need exists to combat authentication systems that would erroneously accept authentication of a truly unauthorized user attempting to gain access using the pattern of a unique, inherently specific biometric parameter from an authorized user (Osten C2 L35-45).

Allowable Subject Matter

18. Claim 32 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

19. Claims 33-48, 50-56, 58-63, 65, and 67 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claim Interpretation

20. After careful review of the original specification and unless expressly noted otherwise by Examiner, Examiner concludes that Applicant is not his own lexicographer. See MPEP § 2111.01 IV.

21. Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023, 1029 (Fed. Cir. 1997), Examiner points to these other sources to support his interpretation of the claims.¹ Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

- I. **database** “A file composed of records, each containing fields together with a set of operations for searching, sorting, recombining and other functions.”
Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997.

22. Furthermore, Examiner notes that claim 32 begins “A system for tokenless biometric authorization. . . .” Additionally, “[c]laims in apparatus form conventionally fall into the 35 U.S.C. §101 statutory category of a ‘machine.’” *Ex parte Donner*, 53 USPQ2d 1699, 1701 (B.P.A.I. 1999)(unpublished), (Paper No. 34, page 5, issued as U.S. Patent 5,999,907). Products may be either machines, manufactures, or compositions of matter. MPEP §2106 IV B. 2 (a). For purposes of applying the prior art,

¹ While most definition(s) are cited because these terms are found in the claims, Examiner may have provided additional definition(s) to help interpret words, phrases, or concepts found in the definitions themselves or in the prior art.

the Examiner therefore finds that Applicant's apparatus claims (*i.e.* claims 32-48, 50-56, 58-63, 65, and 67) are "product" claims or more specifically, "machine" claims.

23. In light of Applicants' choice to pursue product claims (claims 32-48, 50-56, 58-63, 65, and 67), Applicants are reminded that functional recitations using the word and/or phrases "for", "adapted to", or other functional language (*e.g.* see claim 32 which recites "data entry device *for* formation", "device *for* electronically scanning") have been considered but are given little patentable weight because they fail to add any structural limitations and are thereby regarded as intended use language. To be especially clear, all limitations have been considered. However, a recitation of the intended use of the claimed product must result in a structural difference between the claimed product and the prior art in order to patentably distinguish the claimed product from the prior art. If the prior art structure is capable of performing the intended use, then it reads on the claimed limitation. *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) ("The manner or method in which such a machine is to be utilized is not germane to the issue of patentability of the machine itself."); *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). See also MPEP §§ 31.06 II (C.), 2114 and 2115. Unless expressly noted otherwise by the Examiner, the claim interpretation principles in the paragraph apply to all claims currently pending.

24. For compact prosecution purposes, Applicant is reminded that optional or conditional elements do not narrow the claims because they can always be omitted. See *e.g.* MPEP §2106 II C.: "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not

limit the scope of a claim or claim limitation. [Emphasis in original.]"; and *In re Johnston*, 435 F.3d 1381, 77 USPQ2d 1788, 1790 (Fed. Cir. 2006) ("As a matter of linguistic precision, optional elements do not narrow the claim because they can always be omitted.").

m. For claim 68, Examiner is assuming wherein upon a **failed** identification of the user. Therefore, the following limitations of claim 68 would not apply:

- i. "an electronic communication authorization step, wherein upon a successful identification of the user... execution";
- ii. "a rule-module invocation step, wherein upon a successful identification of the user... consumer rewards incentive"; and
- iii. "an electronic communication execution step, wherein upon the invocation of the user-customized rule-module... command."

25. In this case, claims 32 and 68 state "wherein an electronic communication is biometrically-authorized *without* the user having to present smartcards or magnetic stripe cards." To assisting in overcoming prior art rejections, Examiner suggests that Applicant re-write claims 32-48, 50-56, 58-63, 65, and 67-68 in the affirmative, without the 'negative' limitation.

Conclusion

26. Applicant is respectfully reminded that any suggestions or examples of claim language provided by Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by Examiner. To be especially clear, any

suggestion or example provided in this Office Action (or in any future office action) does not constitute a formal requirement mandated by Examiner.

n. Should Applicant decide to amend the claims, Applicant is also reminded that—like always—no new matter is allowed. Examiner therefore leaves it up to Applicant to choose the precise claim language of the amendment in order to ensure that the amended language complies with 35 U.S.C. § 112 1st paragraph.

o. Independent of the requirements under 35 U.S.C. § 112 1st paragraph, Applicant is also respectfully reminded that when amending a particular claim, all claim terms must have clear support or antecedent basis in the specification. See 37 C.F.R. § 1.75(d)(1) and MPEP § 608.01(o). Should Applicant amend the claims such that the claim language *no longer* has clear support or antecedent basis in the specification, an objection to the specification may result. Therefore, in these situations where the amended claim language does not have clear support or antecedent basis in the specification and to prevent a subsequent ‘Objection to the Specification’ in the next office action, Applicant is encouraged to either (1) re-evaluate the amendment and change the claim language so the claims *do* have clear support or antecedent basis or, (2) amend the specification to ensure that the claim language does have clear support or antecedent basis. See again MPEP § 608.01(o) (¶3). Should Applicant choose to amend the specification, Applicant is reminded that—like always—no new matter in the specification is allowed. See 35 U.S.C. § 132(a). If Applicant has any questions

on this matter, Applicant is encouraged to contact Examiner via the telephone number listed below.

27. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Chrystina Zelaskiewicz whose telephone number is 571.270.3940. The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at 571.272.6779.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866.217.9197 (toll-free).

/Chrystina Zelaskiewicz/
Examiner, Art Unit 3621
April 30, 2010

/ANDREW J. FISCHER/
Supervisory Patent Examiner, Art Unit 3621